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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,763	11/20/2000	Satoru Fukushima	FUJ 17.974	8302
7590 09/20/2004				
Katten, Muchin, Zavis & Rosenman		EXAMINER		
575 Madison Ave.		TRAN, THIEN D		
New York, NY 10022-2585				
		ART UNIT	PAPER NUMBER	
		2665		

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,763

Applicant(s)

FUKUSHIMA ET AL.

Examiner

Thien D Tran

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. the drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, ***“a response signal transmitting from a held EP after a predetermined time after a second request signal received, and a first signal transmitting from a hold EP according to claims 1, 2, 6, 7”*** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will

Art Unit: 2665

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 2, 6, 7 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The step of “generating a first request signal and transmitting the generated first request signal to an other party **only when** there is **no** response signal received within a predetermined time after a second request signal transmitted” is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Regarding claims 1, 2, 6, 7, it is not clear to understand how the invention can be achieved when a first request signal is generated in the scenario that a response signal received within a predetermined time after a second request signal transmitted. The response signal received within time only when a held EP supports a remote-end call hold method. Therefore, generating the first request signal for enforcing a near-end call hold method is a redundancy because the first request signal is always generated and sent to the other party no matter what mode the help EP supported. With respect with the logic of the claim's language, Examiner analogizes the invention claimed in claims

Art Unit: 2665

1, 2, 6, 7 similar as the method of remote-end call hold, and that the timer does not have any weight because in the method of remote-end call hold, the "remotehold.inv" signal (second request signal) and "remotehold.rr" signal (response signal) are always generated at the hold EP and held EP.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-7 are rejected under 35 U.S.C. 102(a) as being anticipated by the admitted prior art.

Regarding claims 1, 6, the admitted prior art discloses a communication device which performs communication with other party in a communication network and which has a first function to hold the communication by transmitting a remotehold.inv signal (first request signal) to the other party and a second function to hold the communication by transmitting the remotehold.inv signal (second request signal) to the other party and by receiving a remotehold.rr signal (response signal), said communication device, figure 9B, comprising:

detection means for detecting whether the response signal is received (within a predetermined time) after the second request signal is transmitted, page 4; and

hold control means, in dependence upon the detecting by said detection means, for generating the first request signal and transmitting the generated first request signal to the other party, page 4.

Art Unit: 2665

Regarding claims 2, 7 the admitted prior art discloses a communication network including a first communication device, a second communication device and a gateway keeper (transit device), figure 1, which relays communication between the first and second communication devices, the first communication device having a first function to hold the communication by transmitting a remotehold.inv signal (first request signal) to the second communication device and a second function to hold the communication by transmitting the remotehold.inv signal (second request signal) to the second transit device and by receiving a remotehold.rr signal (response signal), figure 9B, the transit device comprising:

detecting means for detecting whether the response signal is received (within a predetermine time) after the second request signal is relayed, page 4; and

hold control means, in dependence upon the detecting by said detection means, for generating the first request signal and transmitting the generated first request signal to the second communication device and for generating the response signal and transmitting the generated response signal to the first communication device, page 4,.

Regarding claim 3, the admitted prior art discloses the communication device wherein the first request signal is accompanied by a signal indicating a hold condition, page 4.

Regarding claim 4, the admitted prior art discloses the transit device, wherein the first request signal is accompanied by a signal indicating a hold condition, page 4.

Regarding claim 5, the admitted prior art discloses the communication device or transit device respectively, wherein the first request, second request and response

Art Unit: 2665

signals are holdnotification.inv, remotehold.inv and remotehold.rr messages according to ITU-T Recommendation H.225.0 Q.931, page2, figures 9.

Conclusion

5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Thien Tran whose telephone number is (571) 272-3156. The examiner can normally be reached on Monday-Friday from 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (571) 272-3155. Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

Thien Tran



STEVEN NGUYEN
PRIMARY EXAMINER